UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,520	10/17/2000	Heiko Dassow	2345/137	6699

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EXAMINER
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ART UNIT	PAPER NUMBER
2662	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/673,520	DASSOW ET AL.
	Examiner	Art Unit	
	Hanh Nguyen	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 July 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-22 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 11, it is not clearly stated in the specification how the bandwidth is reduced.

Regarding claim 19, the claim states "wherein at least one of the sending and receiving terminals is connected directly or via a digital transmission link to the digital data network so as to avoid a need to first code the data using either of the sending and receiving terminal for the data transmitting over the voice connection path and then a need to decode the coded data." Neither the detailed description nor the figures show or describe this process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Adler et al

(USP 2001/0035977 Al , hereaher Adler). All claims are being examined as best understood by

the Examiner.

Referring to claim 11, Adler discloses a method for reducing bandwidth (by

compressing the data) when transmitting data between a sending teminal and a receiving

terminal over a facsimile (voice) connection path using a digital data network, such as the

Internet (abstract), the method comprising: converting, within the node of the digital data

network, a coding of user information of the transmitted data between a data transmission in the

voice connection path and a data transmission in the digital data network (convert from data

transmitted over the PSTN to a format acceptable to the Internet) so as to transmit the user

information via the coded voice connection path on at least one first section of the digital data

network (at Node 1) and transmit the user information by a method suitable for the digital data

network on at least one second section of the digital data network (over PRMI Net, Fig. 1,

paragraph (0028)-(0030), (0032)-(0034)).

Referring to claim 12, Adler discloses the method as recited in claim 11 wherein the

sending and the receiving terminals use a similar modulation method for transmitting the data

over the voice connection path (paragraph (0003)).

Referring to claim 13, Adler discloses the method as recited in claim 11 wherein no

special functional matching of the sending and receiving terminals is required for the converting

(the data is transmitted across the Intelmet, so the data is received at the nodes without having to

functionally match the sending and receiving tenninals, paragraph (0032)-(0033)).

Referring to claim 14, Adler discloses the method as recited in claim 1 1 wherein no

special adaptation of the sending and receiving terminals to transmission characteristics of the

digital data network is required for the transmission of the user information (paragraph (0032)-

(0033)).

Referring to claim 15, Adler discloses the method as recited in claim 1 1 wherein the

Transmitting of the user infonnation via the coded voice connection path on at least one first

section of the digital data network is perfonned automatically by a context-related call-number

translation during a connection setup so as not to be perceived by the sending and receiving

terminals (the nodes translate the called number to an IP address, the originating and destination

fax do not perform this translation, paragraph ((0032)-(0033)).

Referring to claim 16, Adler discloses the method as recited in claim 15 wherein the

transmitting the user infonnation via the coded voice connection path on at least one first section

of the digital data network is performed such that end-to-end signaling of the sending and

receiving terminals for a sending/receiving terminal control of the data transmission is

terminated at a transition into the digital data network and is newly generated soas to integrate a

control of the data transmission by the digital data network into the end-to-end signaling (the

system sends acknowledgements from destination to source, where the signaling is converted

back and forth from IP signaling to PS'I'N signaling depending on which network the signal is

on, paragraph (0051).

Referring to claim 17, Adler discloses the method as recited in claim 11 wherein the

sending and receiving tenninals use different respective data transmission processes and further

comprising temporarily storing and converting the transmitted data and signaling information so

as to match the respective data transmission processes of the sending and receiving tenninals

such that difference in the respective data transmission processes are not perceived by the

sending and data), a transmission rate of the data packets being

flexibly adapted at a network transition to a bit rate transmitted by the sending terminal (Fig.1,

paragraph (0035).

Referring to claim 19, Adler discloses the method œs recited in claim 1 1 wherein at least

one of the sending and receiving tenninals is connected directly or via a digital transmission link

to the digital data network so as to avoid a need to first code the data using either of the sending

and receiving terminal for the data transmitting over the voice connection path and then a need to

decode the coded data (the fax machine is connected via a digital transmission link to the

destination fax through the Internet, Fig. 1, paragraph (0032)-(0036).

Referring to claim 20, Adler discloses the method as recited in claim 11 wherein the

digital data network includes an interconnection of a plurality of individual data networks

(Fig.1).

Referring to claim 21, Adler discloses the method as recited in claim 11 wherein the

user information to be transmitted conforms to features of FAX class 3 (paragraph (0004)).

Referring to claim 22, Adler discloses the method as recited in claim 11 further

comprising before the transmitting over the digital data network, protecting the data by

cryptographic processes against passive monitoring, alteration and/or simulation of incorrect call

data and/or contents (paragraph 0033).

Response to Arguments

Applicant's arguments filed on 8/2/04 have been fully considered but they are not

persuasive

Referring to 112 first paragraph rejection, Applicant argues that the process of reducing

bandwidth, claimed in claim 11, is described in the specification, pages 12, lines 5-14, 24-25,

page 5, line 7-23 and page 6, lines 11-23. Examiner again reconsiders the cited pages in the

specification and believes that the cited sections do not disclose how the bandwidth is reduced.

Referring to claim 19, after reconsiderring the cited page 8, lines 4-15, page 7, lines 3-7

and page 6, lines 4-7, 16-19, and 21-25 as suggested by Applicant. Examiner believes that the

cited sections do not dislose the process that avoid coding between sending and receiving

terminals.

Referring to 102 rejection, applicant argues on page 8 that Adler does not disclose

transmitting user information via the coded voice path on the first section of digital data network

and transmitting the user information on at least one second section of the digital data network.

Applicant is directed to Adler, Fig.1, wherein a sending terminal (fax 16) transmitting data (fax

transmission) to a receiving terminal (fax 20) over a voice cormection path (via PTN 18) using

a digital data network (Internet PRM1 network 24), the method comprising converting within the

digital data network a coding of user information of the transmitted data (converting normal fax

transmission to digitized compressed data in Internet 24) between a data transmission in the

voice connection path (normal fax transmission via PSTN18) and a data transmission in the

digital data network (digitized compressed data via Internet 24) so as to transmit the user

information via the coded voice connection path (digitized compressed data via link 26) on at

least one first section of the digital data network (link 26) and transmit the user information (

the digitized compressed data) by a method suitable for the digital data network on at least one

second section of the digital data network (via link 28). See Abstract, paragraphs [0028-0030],

[0032-0034].

Therefore, examiner believes that Adler overcomes the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hanh Nguyen whose telephone number is 571 272 3092. The

examiner can normally be reached on Monday to Friday. The examiner can also be reached on

alternate

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hassan Kizou, can be reached on 571 272 3088. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 6, 2005

HANH NGUYEN
PRIMARY EXAMINER